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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,039	07/30/2001	Yong Mi Choi-Sledeski	P24450-E US1	3370

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05/18/2004

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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT PAPER NUMBER

1624

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,039

Applicant(s)

CHOI-SLEDESKI ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,8-12,14,22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,8-12,14,22,24,25 and 28-41 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

The period of suspension has ended. The following action is based on the set of claims in the amendment of 5-27-03. With claims 3-5, 7, 13, 15-21, 23, and 42 cancelled, only claims 1, 2, 6, 8-12, 14, 22, and 24-41 are remained for consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 2, 6, 8-12, 14, 22, 24, 25, and 29-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 2, 8, 11, and 25 recite the term “*substituted*” or “*optionally substituted*” which renders indefinite metes and bounds for said claims because there is no intended moiety following said terms. In the absence of the specific moieties intended to effectuate modification by “substitution” or attachment to the chemical core claimed, the term “substituted” renders the claims in which it appears indefinite in all occurrences wherein applicant fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicant regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

- b. Claims 6, 9, 10, 14, 22, 24, and 29-41 are rejected as being dependent on claim 1, and carrying over limitations that are generally “*substituted*” or “*optionally substituted*”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 6, 8-12, 14, 25, 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by **Salvino et. al.** (US 6,639,023 B1). On columns 90-94, Salvino et. al. (US'023), Salvino et. al. disclose a group of compounds that read on compounds of those claims when the instant formula I has the following substituents:

- X₂ and X_{2a} together form an oxo (i.e., =O);
- X₁, X_{1a}, X₃, and X₄, each represents hydrogen;
- Ar¹ is a pyrrolo[3,2-c]pyridine; or pyrrolo[2,3-c]pyridine;
- R₁ is hydrogen;
- R₂ represents R₃SO_p-; p = 2;

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- R_3 corresponds to R_a of the reference and represents chloro-benzothienyl, thienopyridyl; substituted phenyl, substituted thienyl (e.g., bithienyl, or oxazolylthienyl, etc.).

It is noted that the instant application is a DIV of application 09/453,307 (filed on 12-02-1999) which in turn, is a CIP of 09/ 090,492 (filed on 06-03-1998, now US 6,602,864 B1). A review of US'864 shows that only a few species of the above cited compounds have support in US'864. Thus, the entire formula I does not have full support in US'864, and therefore, is not entitled to the filing date of 06-03-1998 or earlier.

Claim Objections

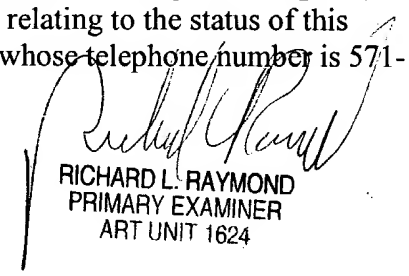
2. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Those claims recite species that are not taught by **Salvino et. al.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

T. Truong
May 14, 2004



RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624